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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,566	02/11/2005	Alessandro Donatelli	FR920030051US1	1122

32329 7590 09/05/2006

IBM CORPORATION  
INTELLECTUAL PROPERTY LAW  
11400 BURNET ROAD  
AUSTIN, TX 78758

EXAMINER
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DU, THUAN N

ART UNIT	PAPER NUMBER
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2116

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/524,566

Applicant(s)

DONATELLI ET AL.

Examiner

Thuan N. Du

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/11/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. It is hereby acknowledged that the following papers have been received and placed of record in the file: Pre-Amendment and IDS (dated 2/11/05).
2. Claims 7, 8 and 10 have been cancelled. Claims 1-6 and 9 are presented for examination.

#### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/639,863 in view of Benignus et al. [Benignus] (U.S. Patent No. 4,888,771). Claim 1 of Application No. 10/639,863 does not disclose the target state of at least one rule being a prerequisite for the target state of at least one further rule, and repeating the application of each failed rule to configure the

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subject entity according to the target state specified in the failed rule when all the corresponding prerequisites are available. Benignus teaches the above-mentioned limitation [col. 9, line 1 to col. 10, line 43]. One of ordinary skill in the art would have recognized that the test would obviously re-occur when the fail subject entity has been fixed. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of the Application No. 10/639,863 to include the prerequisite rules as taught by Benignus because it would increase the functionality and availability of the system.

This is a provisional obviousness-type double patenting rejection.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas et al. [Douglas] (U.S. Patent No. 6,039,688) and Benignus et al. [Benignus] (U.S. Patent No. 4,888,771).

7. Regarding claim 1, Douglas teaches a method substantially as claimed comprising the steps of:

publishing a plurality of rules, by the at least one authority entity, each one defining a target state for a category [col. 6, lines 28-45] (the recommendation corresponds to the published rules);

retrieving the rules corresponding at least one category by each subject entity [col. 6, lines 45-48]; and

applying each retrieved rule to configure the subject entity according to the target state [col. 6, line 64 to col. 7, line 14].

Douglas does not explicitly teach the target state of at least one rule being a prerequisite for the target state of at least one further rule, and repeating the application of each failed rule to configure the subject entity according to the target state specified in the failed rule when all the corresponding prerequisites are available.

Benignus teaches that the target state of at least one rule being a prerequisite for the target state of at least one further rule, and repeating the application of each failed rule to configure the subject entity according to the target state specified in the failed rule when all the corresponding prerequisites are available [col. 9, line 1 to col. 10, line 43]. One of ordinary skill in the art would have recognized that the test would obviously re-occur when the fail subject entity has been fixed.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Douglas include the prerequisite rules as taught by Benignus because it would increase the accuracy of the physician recommendations.

8. Regarding claims 2-5, these claims are directed to method steps for configuring the subject entities of claim 1. As stated above, Douglas and Benignus teach the invention substantially as set forth in claim 1. At the time of the invention, one of ordinary skill in the art would have readily recognized that Douglas and Benignus may obviously also teach the method

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steps of claim 1 as set forth in claims 2-5. As such, claims 2-5 are rejected under the same rationale with respect to claim 1.

9. Regarding claim 6, Douglas and Benignus together teach the claimed method steps. Therefore, Douglas and Benignus together teach the computer program for carrying out the claimed method steps.

10. Regarding claim 9, Douglas and Benignus together teach the claimed method steps. Therefore, Douglas and Benignus together teach the apparatus to implement the claimed method steps.

### *Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuan N. Du whose telephone number is (571) 272-3673. The examiner can normally be reached on Monday-Friday: 9:30 AM - 6:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H. Browne can be reached on (571) 272-3670.

Central TC telephone number is (571) 272-2100.

The fax number for the organization is (571) 273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

TD  
August 31, 2006



**THUAN N. DU**  
**PRIMARY EXAMINER**